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OFFICE OF PETITIONS

In re Application of	:
Barton et al.	: DECISION GRANTING
Application No. 10/727,681	: PETITION
Filed: 4 December, 2003	:
Attorney Docket No. 6794A-	:
000061/US/COG	:

This is a decision on the petition filed on 16 July, 2004, which is treated as a petition requesting that the above-identified application be accorded a filing date of 4 December, 2003, with 91 sheets of drawings as a part of the original disclosure.

The petition is **granted to the extent indicated.**

The application was filed on 4 December, 2003, without drawings.¹ Accordingly, on 18 May, 2004, Initial Patent Examination Division mailed a "Notice of Incomplete Nonprovisional Application" stating, *inter alia*, that no filing date had been assigned because the application was deposited without drawings, and requiring drawings be filed if necessary. In response, on 16 July, 2004, petitioners filed the present petition along with 91 sheets of drawings, starting with sheet 2 of 92.

Petitioners concede that the drawings were inadvertently omitted when the present application was filed, but state that the application as filed was a continuation of application No. 09/732,208, and requested that the drawings from the parent application be transferred to the present application.

Petitioners are advised that there is no provision in the rules or MPEP for the Office to transfer a copy of papers from one application to another. However, petitioners may file the drawings in the present application as a preliminary amendment. No petition under 37 CFR 1.182 is necessary for that purpose. Amendments to the specification may be entered by the primary

¹35 U.S.C. § 113 (first sentence) requires a drawing "where necessary for the understanding of the subject matter sought to be patented."

examiner without petition so long as the amendment contains no new matter.²

Petitioners' assertion that the drawings, which were omitted on filing and a part of a copending application mentioned on the application transmittal sheet are a part of the original disclosure, is not persuasive. Whether the drawings which petitioners intended to file with this application were a part of a copending application is not an issue here since the copending application was not specifically incorporated by reference into the disclosure of this application.³ The mere reference to another application is not an incorporation of anything therein into the application containing the reference.⁴ To allow one to retroactively incorporate by reference a second application into a first application would allow the addition of matter into an application that was not present on filing which would be contrary to our statutes and rules. Still further, the question of new matter is not an issue here. The drawings which petitioners seek entry of were simply not filed in the USPTO on 4 December, 2003.

In addition to a properly itemized postcard, petitioner may avoid in the future the predicament which has occurred by including, in the application-as-filed, a statement that such specifically enumerated prior application or applications are "hereby incorporated herein by reference." The statement may appear in the specification or in the application transmittal letter. The inclusion of this incorporation by reference of the prior application(s) will permit petitioner to amend the continuing application to include any subject matter in such prior application(s), without the need for a petition.⁵

Nevertheless, it has been PTO practice to treat an application that contains at least one process or method claim as an application for which a drawing is not necessary for an understanding of the invention under 35 U.S.C. 113 (first

²37 CFR 1.121(b).

³See MPEP 608.01(p).

⁴See In re de Seversky, 177 USPQ 144, 146 (C.C.P.A. 1973); Dart Industries v. Banner, 207 USPQ 273, 276 (D.C. Cir. 1980).

⁵MPEP 201.06(c).

sentence).⁶ A review of the record reveals that Claim 29 is a method claim. Therefore, the present application is deemed to be an application which does not require a drawing for an understanding of the invention. Accordingly, the application, as filed, is entitled to a filing date.

The petition is granted. Since the petition was necessitated by an error on the part of the USPTO, the petition fee submitted on 16 July, 2004, will be credited to counsel's deposit account, No. 08-0750.

The "Notice of Incomplete Nonprovisional Application" mailed on 18 May, 2004, is hereby vacated to the extent that it states that the application has not been accorded a filing date.

The application will be processed and examined using only the application papers filed on 16 July, 2004. The 91 sheets of drawings filed with the present petition will not be used for processing or examination, but will be retained in the application file.

Receipt of the associate power of attorney and change of address filed on 16 July, 2004, is acknowledged.

The application is being forwarded to the Office of Initial Patent Examination for further processing with a filing date of 4 December, 2003, using only the application papers present on filing.

Telephone inquiries specific to this matter should be directed to the undersigned at 703.308.6918.



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⁶MPEP 601.01(f).